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REMARKS

Claims 1-81 are in the case. Applicants present the following remarks demonstrating that the case is in condition for allowance.

Response to Office Action Dated January 6, 2005

Claim Rejections – 35 U.S.C. §112

Claims 16-20 stand rejected under 35 U.S.C § 112 as being indefinite for reciting the limitation “wherein user instruction” without providing proper antecedent basis. Claims 16-20 as filed contained a mere typographical error and depended from claim 1 instead of claim 15. Claims 16-20 have been amended to correct this typographical error and the rejection should be withdrawn.

Claim Rejections – 35 U.S.C. §102 Over Eldering

Claims 1, 4-6, 14-15, 20, and 24-27 stand rejected under 35 U.S.C § 102(e) as being anticipated by Eldering, *et al.* (U.S. Patent Application Publication No. 2002/0111154). To anticipate claims 1, 4-6, 14-15, 20, and 24-27 under 35 U.S.C. § 102(e), two basic requirements must be met. The first requirement of anticipation is that Eldering must disclose each and every element as set forth in Applicants’ claims. The second requirement of anticipation is that Eldering must enable Applicants’ claims. Eldering does not meet either requirement and therefore does not anticipate Applicants’ claims.

Eldering Does Not Disclose Each and Every Element
Of The Claims Of The Present Application

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.

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1987). As explained in more detail below, Eldering does not disclose each and every element of claim 1, and Eldering therefore cannot be said to anticipate the claims of the present application within the meaning of 35 U.S.C. § 102.

Claim 1 claims:

A method for communication of location specific content to client devices,
the method comprising the steps of:

identifying a client device at a location of a location specific device,
wherein the client device comprises client device attributes, the client
device attributes comprising a client device identification code, and
wherein the location specific device comprises a location identification
code;

recording user preferences for the client device;

selecting, in dependence upon the user preferences for the client device
and upon the location identification code, content for transmission to the
client device;

transmitting the selected content through the location specific device to the
client device for presentation; and

enabling retention of the content within the client device for a period of
time.

The Office Action states that Eldering discloses identifying a client device at a location of a location specific device at page 3, paragraph 33. Page 3, paragraph 33 of Eldering actually discloses:

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[0033] FIG. 1 illustrates a simplistic wireless network 100 connecting a wireless device 110 to a final destination 120 via a network 130. As illustrated the wireless device 110 is a wireless phone. However, as would be obvious to one of ordinary skill in the art, the wireless device 110 could be a personal digital assistant (PDA), such as a PALM Pilot or Handspring Visor, an internet enabled vehicle, a portable computer having a wireless Internet connection, a combination wireless phone/PDA or any other device now known or later conceived that provides wireless communications. As illustrated the final destination 120 is a stationary phone, but could be a wireless phone, a beeper, a service provider, the Internet, a private network, a computer, or numerous other devices without departing from the scope of the current invention.

Paragraph 33 discloses connecting a wireless device 110 to a final destination 120 via a network 130. Paragraph 33 does not disclose "a location specific device." In fact, paragraph 33 does not even mention "a location specific device." Eldering therefore does not disclose each and every element of claim 1 and the rejection should be withdrawn.

The Office Action also states that Eldering discloses wherein the client device comprises client device attributes, the client device attributes comprising a client device identification code at page 4, paragraph 40 and page 5, paragraph 49. Page 4, paragraph 40 and page 5, paragraph 49, of Eldering actually disclose:

[0040] Thus in a preferred embodiment, characteristics about the subscriber (i.e., a subscriber profile) will be known so that the delivery of advertisements, services and information can be tailored (targeted) to that subscriber. For example, if you know that the subscriber likes nice cars you may send him an advertisement for the local BMW dealers in the local area. The characteristics about the subscriber may include demographics, psychographics, product preferences, service preferences, hobbies, likes, dislikes, other categories, or combinations thereof. The

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characteristics may be provided by the subscriber, may be generated based on actions of the subscriber, or some combination thereof. The subscriber may provide the information by filling out a survey or may simply provide any information they decide is relevant and worth sharing. The actions that may be used to characterize the subscriber include but are not limited to purchases (products and/or services), channel changes, Internet browsing, locations visited, routes, other transactions, and combinations thereof

[0049] FIG. 3 illustrates a communication platform for supporting the method and system of the present invention. The subscriber 210 is connected to the wireless network 100 via the wireless device 110. As the subscriber 210 roams, his/her location is determined either by the wireless network 100 or by using the GPS network 160. Data related to the subscriber's location (location data) is forwarded to a subscriber location database 310 and the service/content provider 250. The subscriber location database 310 may be part of the wireless network 100 or may be external to the wireless network 100. The location data may be sent to the subscriber location database 310 directly from the wireless network 100 or via a network 300. The network 300 may be a telecom network, a private network, the Internet, or any other network capable of providing communications. The wireless service provider may maintain the subscriber location database 310 or a third party may maintain it. The location data saved may be raw data or may be aggregated data.

Page 4, paragraph 40 and page 5, paragraph 49 of Eldering discloses a subscriber profile and sending location data to a subscriber location database from a wireless network or a network. Page 4, paragraph 40 and page 5, paragraph 49, do not disclose "client device attributes" or "client device identification codes." The cited portions of Eldering do not even mention "client device attributes" or "client device identification codes." Eldering does not disclose each and every element of claim 1 and the rejection should be withdrawn.

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The Office Action also states that Eldering discloses the location specific device comprises a location identification code at page 3, paragraph 37. Page 3, paragraph 37 of Eldering actually discloses:

[0037] When the wireless device 110 initiates communications, a signal is sent from the wireless device 110 and is received by the receivers 150. The appropriate receiver 150 forwards the signal based on who the service provider is, whether they actually provide service in that location or are contracting with a local provider, and the destination of the communication. The location of the subscriber can be identified by the wireless system. For example, determining the difference in time that the signal is received at three towers or the difference in the angle that the signal is received at two towers can identify the location. Alternatively, a GPS chipset that is located within the device can determine the location of the subscriber.

Page 3, paragraph 37 of Eldering discloses a signal being sent from a wireless device and received receivers and the signal or a chip set identifying the location of the subscriber. Page 3, paragraph 37 does not disclose "the location specific device comprises a location identification code." In fact, the cited portions of Eldering do not even mention "a location identification code." Eldering does not disclose each and every element of claim 1 and the rejection should be withdrawn.

The Office Action also states that Eldering discloses recording user preferences for the client device at page 5, paragraph 50. Page 5, paragraph 50 of Eldering actually discloses:

[0050] According to a preferred embodiment of the current invention, in addition to location data being stored in the subscriber location database 310, the time associated with the location will also be stored. The

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subscriber profiler 230 extracts data from the subscriber location database 310 and generates predicted activities and/or routes for the subscriber 210. In addition, the subscriber profiler 230 extracts data from a location profile/attribute database 320. The location profile/attribute database 320 consists of data related to locations. For example, the location profile/attribute database 320 may include the type of businesses, stores, points of interests, etc. associated with locations. Moreover, the location profile/attribute database 320 may include data on characteristics associated with the location, intended visitors to the location, establishments within the location, etc. The characteristics may include but are not limited to demographics, store preferences, product preferences, likes and dislikes.

Page 5, paragraph 50 of Eldering discloses a subscriber profiler that extracts data from a subscriber location database and generates predicted activities and/or routes for the subscriber. Page 5, paragraph 50 does not disclose "recording user preferences for the client device." In fact, the cited portions of Eldering do not even mention "recording user preferences for the client device." Eldering does not disclose each and every element of claim 1 and the rejection should be withdrawn.

The Office Action also states that Eldering discloses enabling retention of the content within the client device for a period of time at page 1, paragraph 8 and page 7, paragraphs 66-67. Page 1, paragraph 8 and page 7, paragraphs 66-67 of Eldering actually disclose:

[0008] The use of GPS systems (GPSS) to determine an individual's location is becoming wide spread. For example, handheld devices have been developed that include a GPS receiver to determine an individual's location and map data so that the position of the individual can be displayed on a map. U.S. Pat. No. 5,528,248 assigned to Trimble Navigation discloses a personal location assistant (PLA), comprised of technology sufficient to determine present position as well as a compass

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that provides for taking readings of present and prior headings. The PLA is capable of receiving a downloadable map and retaining the map in computer memory. The PLA is then capable of providing directional readings, determining the devices position in terms of longitude and latitude, and overlaying the co-ordinations on a displayed digital map. The current heading can also then be displayed as an overlay allowing for highly accurate real time navigation.

[0066] According to one embodiment, the subscriber profiler 230 uses the location and time data to predict the subscriber activity and/or the subscriber route (420). The generation of predicted activities/routes is disclosed in Applicant's co-pending U.S. Application No. XX/XXX,XXX (attorney docket no. L100-10) entitled "Location Based Profiling" filed concurrently with the present application, which is herein incorporated by reference in its entirety. For example, the activity may be commuting and the route may be via I95. According to one embodiment, the subscriber profiler 230 transmits the subscriber profile and the predicted activity/route to the advertiser (425). The predicted activity/route may be delivered by itself or with some combination of location, time, and subscriber profile.

[0067] According to one embodiment, the subscriber profiler 230 uses the location and time data (as well as attributes associated with the locations) to update the subscriber profile (430). The generation of the subscriber profile is disclosed in Applicant's co-pending U.S. Application No. XX/XXX,XXX (attorney docket no. L100-10) entitled "Location Based Profiling" filed concurrently with the present application, which is herein incorporated by reference in its entirety. For example, the subscriber profile may be updated to reflect a change in lifestyle, such as a new job or new child, or may reflect a change in tastes, such as a new favorite restaurant, or may simply refine the existing subscriber profile. The

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updated profile may be provided to the advertiser 250 (435). The updated profile may be delivered by itself or with some combination of location, time, and predicted activity/route.

Page 1, paragraph 8 and page 7, paragraphs 66-67, of Eldering actually disclose using GPS systems to determine an individual's location, using location and time data to predict subscriber activity and/or subscriber route, and updating a subscriber profile. Page 1, paragraph 8 and page 7, paragraphs 66-67, of Eldering do not disclose enabling retention of the content within the client device for a period of time as claimed in claim 1. In fact, the cited portions of Eldering do not even mention "enabling retention of the content within the client device for a period of time." Eldering does not disclose each and every element of claim 1 and the rejection should be withdrawn.

Eldering Does Not Enable Each and Every Element
Of The Claims Of The Present Application

Not only must Eldering disclose each and every element of the claims of the present application within the meaning of *Verdegaal* in order to anticipate Applicants' claims, but also Eldering must be an enabling disclosure of each and every element of the claims of the present application within the meaning of *In re Hoeksema*. In *Hoeksema*, the claims were rejected because an earlier patent disclosed a structural similarity to the applicant's chemical compound. The court in *Hoeksema* stated: "We think it is sound law, consistent with the public policy underlying our patent law, that before any publication can amount to a statutory bar to the grant of a patent, its disclosure must be such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention." *In re Hoeksema*, 399 F.2d 269, 273, 158 USPQ 596, 600 (CCPA 1968). The meaning of *Hoeksema* for the present case is that unless Eldering places Applicants' claims in the possession of a person of ordinary skill in the art, Eldering is legally insufficient to anticipate Applicants' claims under 35 U.S.C. § 102.

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Claim 1 claims:

1. A method for communication of location specific content to client devices, the method comprising the steps of:

identifying a client device at a location of a location specific device, wherein the client device comprises client device attributes, the client device attributes comprising a client device identification code, and wherein the location specific device comprises a location identification code;

recording user preferences for the client device;

selecting, in dependence upon the user preferences for the client device and upon the location identification code, content for transmission to the client device;

transmitting the selected content through the location specific device to the client device for presentation; and

enabling retention of the content within the client device for a period of time.

The Office Action states that Eldering discloses identifying a client device at a location of a location specific device at page 3, paragraph 33. Page 3, paragraph 33, of Eldering actually discloses:

[0033] FIG. 1 illustrates a simplistic wireless network 100 connecting a wireless device 110 to a final destination 120 via a network 130. As illustrated the wireless device 110 is a wireless phone. However, as would be obvious to one of ordinary skill in the art, the wireless device 110 could be a personal digital assistant (PDA), such as a PALM Pilot or Handspring Visor, an internet enabled vehicle, a portable computer having a wireless Internet connection, a combination wireless phone/PDA or any other

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device now known or later conceived that provides wireless communications. As illustrated the final destination 120 is a stationary phone, but could be a wireless phone, a beeper, a service provider, the Internet, a private network, a computer, or numerous other devices without departing from the scope of the current invention.

Paragraph 33 discloses connecting a wireless device 110 to a final destination 120 via a network 130. Paragraph 33 does not place one of skill in the art in possession of "a location specific device." In fact, paragraph 33 does not even mention "a location specific device." Eldering therefore does not place one of skill in the art in possession of claim 1 and the rejection should be withdrawn.

The Office Action also states that Eldering discloses wherein the client device comprises client device attributes, the client device attributes comprising a client device identification code at page 4, paragraph 40 and page 5, paragraph 49. Page 4, paragraph 40 and page 5, paragraph 49 of Eldering actually disclose:

[0040] Thus in a preferred embodiment, characteristics about the subscriber (i.e., a subscriber profile) will be known so that the delivery of advertisements, services and information can be tailored (targeted) to that subscriber. For example, if you know that the subscriber likes nice cars you may send him an advertisement for the local BMW dealers in the local area. The characteristics about the subscriber may include demographics, psychographics, product preferences, service preferences, hobbies, likes, dislikes, other categories, or combinations thereof. The characteristics may be provided by the subscriber, may be generated based on actions of the subscriber, or some combination thereof. The subscriber may provide the information by filling out a survey or may simply provide any information they decide is relevant and worth sharing. The actions that may be used to characterize the subscriber include but are not limited to

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purchases (products and/or services), channel changes, Internet browsing, locations visited, routes, other transactions, and combinations thereof:

[0049] FIG. 3 illustrates a communication platform for supporting the method and system of the present invention. The subscriber 210 is connected to the wireless network 100 via the wireless device 110. As the subscriber 210 roams, his/her location is determined either by the wireless network 100 or by using the GPS network 160. Data related to the subscriber's location (location data) is forwarded to a subscriber location database 310 and the service/content provider 250. The subscriber location database 310 may be part of the wireless network 100 or may be external to the wireless network 100. The location data may be sent to the subscriber location database 310 directly from the wireless network 100 or via a network 300. The network 300 may be a telecom network, a private network, the Internet, or any other network capable of providing communications. The wireless service provider may maintain the subscriber location database 310 or a third party may maintain it. The location data saved may be raw data or may be aggregated data.

Page 4, paragraph 40 and page 5, paragraph 49, of Eldering actually discloses a subscriber profile and sending location data to a subscriber location database from a wireless network or a network. Page 4, paragraph 40 and page 5, paragraph 49, do not place one of skill in the art in possession of "client device attributes" or "client device identification codes." The cited portions of Eldering do not even mention "client device attributes" or "client device identification codes." Eldering does not place one of skill in the art in possession of claim 1 and the rejection should be withdrawn.

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[0037] When the wireless device 110 initiates communications, a signal is sent from the wireless device 110 and is received by the receivers 150.

The appropriate receiver 150 forwards the signal based on who the service provider is, whether they actually provide service in that location or are contracting with a local provider, and the destination of the communication. The location of the subscriber can be identified by the wireless system. For example, determining the difference in time that the signal is received at three towers or the difference in the angle that the signal is received at two towers can identify the location. Alternatively, a GPS chipset that is located within the device can determine the location of the subscriber.

Page 3, paragraph 37, of Eldering actually discloses a signal being sent from a wireless device and received receivers and the signal or a chip set identifying the location of the subscriber. Page 3, paragraph 37, does not therefore place on of skill in the art in possession of "the location specific device comprises a location identification code." In fact, the cited portions of Eldering do not even mention "a location identification code." Eldering does not place one of skill in the art in possession of claim 1 and the rejection should be withdrawn.

The Office Action also states that Eldering discloses recording user preferences for the client device at page 5, paragraph 50. Page 5, paragraph 50, of Eldering actually discloses:

[0050] According to a preferred embodiment of the current invention, in addition to location data being stored in the subscriber location database 310, the time associated with the location will also be stored. The subscriber profiler 230 extracts data from the subscriber location database 310 and generates predicted activities and/or routes for the subscriber 210. In addition, the subscriber profiler 230 extracts data from a location profile/attribute database 320. The location profile/attribute database 320

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consists of data related to locations. For example, the location profile/attribute database 320 may include the type of businesses, stores, points of interests, etc. associated with locations. Moreover, the location profile/attribute database 320 may include data on characteristics associated with the location, intended visitors to the location, establishments within the location, etc. The characteristics may include but are not limited to demographics, store preferences, product preferences, likes and dislikes.

Page 5, paragraph 50, of Eldering actually discloses a subscriber profiler that extracts data from a subscriber location database and generates predicted activities and/or routes for the subscriber. Page 5, paragraph 50, does not place one of skill in the art in possession of "recording user preferences for the client device." In fact, the cited portions of Eldering do not even mention "recording user preferences for the client device." Eldering does not place one of skill in the art in possession of claim 1 and the rejection should be withdrawn.

The Office Action also states that Eldering discloses enabling retention of the content within the client device for a period of time at page 1, paragraph 8 and page 7, paragraphs 66-67. Page 1, paragraph 8 and page 7, paragraphs 66-67, of Eldering actually disclose:

[0008] The use of GPS systems (GPSS) to determine an individual's location is becoming wide spread. For example, handheld devices have been developed that include a GPS receiver to determine an individual's location and map data so that the position of the individual can be displayed on a map. U.S. Pat. No. 5,528,248 assigned to Trimble Navigation discloses a personal location assistant (PLA), comprised of technology sufficient to determine present position as well as a compass that provides for taking readings of present and prior headings. The PLA is capable of receiving a downloadable map and retaining the map in computer memory. The PLA is then capable of providing directional

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readings, determining the devices position in terms of longitude and latitude, and overlaying the co-ordinations on a displayed digital map. The current heading can also then be displayed as an overlay allowing for highly accurate real time navigation.

[0066] According to one embodiment, the subscriber profiler 230 uses the location and time data to predict the subscriber activity and/or the subscriber route (420). The generation of predicted activities/routes is disclosed in Applicant's co-pending U.S. Application No. XX/XXX,XXX (attorney docket no. L100-10) entitled "Location Based Profiling" filed concurrently with the present application, which is herein incorporated by reference in its entirety. For example, the activity may be commuting and the route may be via I95. According to one embodiment, the subscriber profiler 230 transmits the subscriber profile and the predicted activity/route to the advertiser (425). The predicted activity/route may be delivered by itself or with some combination of location, time, and subscriber profile.

[0067] According to one embodiment, the subscriber profiler 230 uses the location and time data (as well as attributes associated with the locations) to update the subscriber profile (430). The generation of the subscriber profile is disclosed in Applicant's co-pending U.S. Application No. XX/XXX,XXX (attorney docket no. L100-10) entitled "Location Based Profiling" filed concurrently with the present application, which is herein incorporated by reference in its entirety. For example, the subscriber profile may be updated to reflect a change in lifestyle, such as a new job or new child, or may reflect a change in tastes, such as a new favorite restaurant, or may simply refine the existing subscriber profile. The updated profile may be provided to the advertiser 250 (435). The updated profile may be delivered by itself or with some combination of location, time, and predicted activity/route.

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Page 1, paragraph 8 and page 7, paragraphs 66-67, of Eldering actually disclose using GPS systems to determine an individual's location, using location and time data to predict subscriber activity and/or subscriber route, and updating a subscriber profile. Page 1, paragraph 8 and page 7, paragraphs 66-67, of Eldering do not place one of skill in the art in possession of enabling retention of the content within the client device for a period of time as claimed in claim 1. In fact, the cited portions of Eldering do not even mention "enabling retention of the content within the client device for a period of time." Eldering does not place one of skill in the art in possession of claim 1 and the rejection should be withdrawn.

Relations Among Claims

Independent claims 28 and 55 claim system and computer program product aspects of the method claimed in claim 1. Claims 28 and 55 therefore are patentable for the same reasons that claim 1 is patentable as described above. Dependent claims 2-27, 29-54, and 56-81 depend respectively from independent claims 1, 28, and 55. The dependent claims include each and every limitation of the independent claims from which they depend. The dependent claims stand because their respective independent claims stand.

Claim Rejections – 35 U.S.C. § 103

Claims 2-3 and 7-13 stand rejected under 35 U.S.C § 103(a) as unpatentable over Eldering *et al.* (U.S. Patent Application Publication No. 2002/0111154) in view of Balog *et al.* (U.S. Patent Application Publication No. 2002/0022453). Claims 16-19 and 21 stand rejected under 35 U.S.C § 103(a) as unpatentable over Eldering *et al.* (U.S. Patent Application Publication No. 2002/0111154) in view of Hicks, III *et al.* (U.S. Patent Application Publication No. 2004/0261112). Claims 22-23 stand rejected under 35 U.S.C § 103(a) as unpatentable over Eldering *et al.* (U.S. Patent Application Publication No. 2002/0111154) in view of Kim *et al.* (U.S. Patent Application Publication No.

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2002/0052925). Applicants respectfully traverse each rejection. To establish a prima facie case of obviousness, three basic criteria must be met. *Manual of Patent Examining Procedure* §2142. The first element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a suggestion or motivation to combine the references. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The second element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a reasonable expectation of success in the proposed combination of the references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). The third element of a prima facie case of obviousness under 35 U.S.C. § 103 is that the proposed combination of the references must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974).

Eldering in view of Balog

Claims 2-3 and 7-13 stand rejected under 35 U.S.C § 103(a) as unpatentable over Eldering *et al.* (U.S. Patent Application Publication No. 2002/0111154) in view of Balog *et al.* (U.S. Patent Application Publication No. 2002/0022453). The proposed combination of Eldering and Balog cannot establish a prima facie case of obviousness because the proposed combination does not teach each and every element of the claims of the present application and there is no suggestion or motivation to make the proposed combination.

The Combination Of Eldering and Balog

Does Not Teach all Of Applicants' Claim Limitation

Claims 2-3 and 7-13 depend from claim 1 and include all the limitations of claim1. As discussed above, Eldering discloses location based delivery. Eldering, however, fails to disclose communication of location specific content to client devices including identifying a client device at a location of a location specific device, wherein the client device comprises client device attributes, the client device attributes comprising a client device identification code, and wherein the location specific device comprises a location

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identification code; recording user preferences for the client device; selecting, in dependence upon the user preferences for the client device and upon the location identification code, content for transmission to the client device; transmitting the selected content through the location specific device to the client device for presentation; and enabling retention of the content within the client device for a period of time as claimed in claim 1. Balog does not cure what Eldering fails to disclose. Instead, Balog discloses determining an optimal protocol and selecting a device for content delivery. Balog, page 1, paragraph 1. The combination of Eldering and Balog does not disclose each and every element of claim 1. The combination of Eldering and Balog therefore cannot establish a prima facie case of obviousness.

No Suggestion or Motivation to Combine Eldering and Balog

To establish a prima facie case of obviousness, there must be a suggestion or motivation to combine Eldering and Balog. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The suggestion or motivation to combine Eldering and Balog must come from the teaching of Eldering and Balog, and the Examiner must explicitly point to the teaching within Eldering and Balog suggesting the proposed modification. Absent such a showing, the Examiner has impermissibly used "hindsight" occasioned by Applicants' own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.2d 488m 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.,2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989).

The Office Action at page 5 states as its sole rationale for motivation to combine Eldering and Balog:

The Balog reference teaches a client device identification cone comprises a network address (Balog: page 3, para 29; page 5, claim5).

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The Balog references further teaches the invention determines optimal protocol and to select a device for successful content delivery (Balog: page 1, para 1).

Therefore it would have been obvious at the time of the invention to one of ordinary skill in the art to create the method of communication of location specific content to devices as taught by Eldering while incorporating network addresses as taught by Balog in order to successfully deliver content (Balog: page 1, para 1).

In fact, Balog at page 3, paragraph 29, merely describes in general terms the use of a global profile of dynamic routing of content, suggesting nothing whatsoever about combining Balog and Eldering. Balog at page 5, claim 5, merely claims a device address including a MAC address, an email address, a phone number, a pager number, and an IP address, suggesting nothing whatsoever about combining Balog and Eldering. Balog at page 1, paragraph 1 merely describes in general terms the field of Balog, suggesting nothing whatsoever about combining Balog and Eldering. The office action does not point to any disclosure in Balog or Eldering suggesting their combination. As such, the proposed combination of Balog and Eldering cannot establish a prima facie case of obviousness.

Eldering in view of Hicks

Claims 16-19 and 21 stand rejected under 35 U.S.C § 103(a) as unpatentable over Eldering *et al.* (U.S. Patent Application Publication No. 2002/0111154) in view of Hicks, III *et al.* (U.S. Patent Application Publication No. 2004/0261112). The proposed combination of Eldering and Hicks cannot establish a prima facie case of obviousness because the proposed combination does not teach each and every element of the claims of the present application and there is no suggestion or motivation to make the proposed combination.

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The combination Of Eldering and Hicks
Does Not Teach all Of Applicants' Claim Limitation

Claims 16-19 and 21 depend from claim 1 and include all the limitations of claim 1. As discussed above, Eldering discloses location based delivery. Eldering, however, fails to disclose communication of location specific content to client devices including identifying a client device at a location of a location specific device, wherein the client device comprises client device attributes, the client device attributes comprising a client device identification code, and wherein the location specific device comprises a location identification code; recording user preferences for the client device; selecting, in dependence upon the user preferences for the client device and upon the location identification code, content for transmission to the client device; transmitting the selected content through the location specific device to the client device for presentation; and enabling retention of the content within the client device for a period of time as claimed in claim 1. Hicks does not cure what Eldering fails to disclose. Instead, Hicks discloses multimedia-on-demand services. Hicks, abstract; page 1, paragraph 1. The combination of Eldering and Hicks does not disclose each and every element of claim 1. That is, the combination of Eldering and Hicks does not disclose communication of location specific content to client devices as claimed in claim 1. The combination of Eldering and Hicks therefore cannot establish a prima facie case of obviousness.

No Suggestion or Motivation to Combine Eldering and Hicks

To establish a prima facie case of obviousness, there must be a suggestion or motivation to combine Eldering and Hicks. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The suggestion or motivation to combine Eldering and Hicks must come from the teaching of Eldering and Hicks, and the Examiner must explicitly point to the teaching within Eldering and Hicks suggesting the proposed modification. Absent such a showing, the Examiner has impermissibly used "hindsight" occasioned by Applicants' own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 U.S.P.Q.2d

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1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.2d 488m 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.,2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989).

The Office Action at page 6 states as its sole rationale for motivation to combine Eldering and Hicks:

The Hicks reference teaches user instruction include an instruction to pause presentation of content (Hicks: page 3, para 25; page 4, para 40).

The Hicks references further teaches the invention provides on demand multimedia content like video, audio, TV, web and email (Hicks: page 1, para 5-6).

Therefore it would have been obvious at the time of the invention to one of ordinary skill in the art to create the method of communication of location specific content to devices as taught by Eldering while incorporating instructions to pause as taught by Hicks in order to view and control on demand content (Hicks: page 1, para 5-6).

In fact, Hicks at page 3, paragraph 25, merely describes in general terms the use of a playback control with downloaded multimedia content, suggesting nothing whatsoever about combining Hicks and Eldering. Hicks at page 4, paragraph 40, merely describes in general terms a mass storage device, suggesting nothing whatsoever about combining Hicks and Eldering. Hicks at page 1, paragraphs 5-6, merely describes in general terms the costs of enhanced set top boxes, suggesting nothing whatsoever about combining Hicks and Eldering. The Office Action does not point to any disclosure in Hicks or Eldering suggesting their combination. As such, the proposed combination of Hicks and Eldering cannot establish a prima facie case of obviousness.

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Eldering in view of Kim

Claims 22-23 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Eldering *et al.* (U.S. Patent Application Publication No. 2002/0111154) in view of Kim *et al.* (U.S. Patent Application Publication No. 2002/0052925). The proposed combination of Eldering and Kim cannot establish a prima facie case of obviousness because the proposed combination does not teach each and every element of the claims of the present application and there is no suggestion or motivation to make the proposed combination.

The Combination Of Eldering and Kim
Does Not Teach all Of Applicants' Claim Limitation

Claims 22-23 depend from claim 1 and include all the limitations of claim 1. As discussed above, Eldering discloses location based delivery. Eldering, however, fails to disclose communication of location specific content to client devices, including identifying a client device at a location of a location specific device, wherein the client device comprises client device attributes, the client device attributes comprising a client device identification code, and wherein the location specific device comprises a location identification code; recording user preferences for the client device; selecting, in dependence upon the user preferences for the client device and upon the location identification code, content for transmission to the client device; transmitting the selected content through the location specific device to the client device for presentation; and enabling retention of the content within the client device for a period of time as claimed in claim 1. Kim does not cure what Eldering fails to disclose. Instead, Kim discloses delivering targeted multimedia or video advertisements over the Internet while protecting user privacy. Kim, abstract; page 1, paragraph 3. The combination of Eldering and Kim does not disclose each and every element of claim 1. That is, the combination of Eldering and Kim does not disclose communication of location specific content to client devices as claimed in claim 1. The combination of Eldering and Kim therefore cannot establish a prima facie case of obviousness.

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No Suggestion or Motivation to Combine Eldering and Kim

To establish a prima facie case of obviousness, there must be a suggestion or motivation to combine Eldering and Kim. *In re Vaack*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The suggestion or motivation to combine Eldering and Kim must come from the teaching of Eldering and Kim, and the Examiner must explicitly point to the teaching within Eldering and Kim suggesting the proposed modification. Absent such a showing, the Examiner has impermissibly used "hindsight" occasioned by Applicants' own teaching to reject the claims. *In re Surto*, 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed. Cir. 1997); *In re Vaack*, 947 F.2d 488m 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989).

The Office Action at page 8 states as its sole rationale for motivation to combine Eldering and Kim:

The Kim reference teaches transmitting to the client device an expiration date and time of the selected content transmitted to the device for presentation (Kim: page 12, para 159).

The Kim references further teaches the invention monitors the user's activity and downloads and stores materials when user usage is low to present content instantaneously later (Kim: page 3, para 44).

Therefore it would have been obvious at the time of the invention to one of ordinary skill in the art to create the method of communication of location specific content to devices as taught by Eldering while incorporating expiration dates as taught by Kim in order to present content instantaneously without further download (Kim: page 3, para 44).

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In fact, Kim at page 12, paragraph 159, merely describes in general terms the use of information archival and retrieval, suggesting nothing whatsoever about combining Kim and Eldering. Kim at page 3, paragraph 44, merely describes in general terms monitoring a user's activity and downloading materials, suggesting nothing whatsoever about combining Kim and Eldering. The Office Action does not point to any disclosure in Kim or Eldering suggesting their combination. As such, the proposed combination of Kim and Eldering cannot establish a prima facie case of obviousness.

Conclusion

Claims 16-20 stand rejected under 35 U.S.C § 112 as being indefinite for reciting the limitation "wherein user instruction" without providing proper antecedent basis due to minor typographical error. Claims 16-20 have been amended to correct this typographical error and the rejection should be withdrawn.

Claims 1, 4-6, 14-15, 20, and 24-27 stand rejected under 35 U.S.C § 102(e) as being anticipated by Eldering (U.S. Patent Application No. 2002/0111154). Eldering fails to disclose each and every element as set forth in Applicants' claims and fails to enable Applicants' claims. Eldering therefore does not anticipate Applicants' claims.

Claims 2-3 and 7-13; 16-19 and 21; and 22-23 stand rejected under 35 U.S.C § 103(a) as unpatentable over Eldering in view of Balog, Hicks, and Kim respectively. The combination of Eldering and Balog, Hicks, or Kim cannot establish a prima facie case because the combinations do not teach or suggest all of Applicants' claim limitations and there is no suggestion or motivation to make the proposed combinations.

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The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Respectfully submitted,

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